

Appl. No. 09/678,364
Amdt. Dated September 28, 2004
Reply to Office action of February 13, 2004
Attorney Docket No. P12309-US1
EUS/J/P/04-8853

REMARKS/ARGUMENTS

1.) Claim Rejections – 35 U.S.C. §103(a)

The Examiner rejected claims 1-2 and 4-6 as being unpatentable over Denman *et al.* (US 6,490,451) in view of Reed, *et al.* (US 5,896,440 Reed); and claim 3 as being unpatentable over Denman in view of Reed and further in view of Rose *et al.* (US 6,396,840). For the following reasons, the Applicants traverse the rejections.

a.) Finality of Office Action is Improper

In the prior office action, the Examiner rejected claims 1, 2 and 4-6 as being anticipated by United States Patent No. 6,490,451 issued to Denman, *et al.* The Examiner has now rejected those claims as being obvious in view of Denman and Reed. It is improper for the Examiner to reject Applicant's arguments traversing a §102 rejection by asserting a new reference (Reed). The Examiner is asserting a new ground of rejection which was not necessitated by substantive claim amendments.¹ See: MPEP §107.07(a). If the Examiner desires to reject Applicants' claims, and arguments, based on a combination of references, he should withdraw the finality of the present Office Action and issue a new Office Action clearly supporting his rejection based on such combination of references. Accordingly, the Applicants traverse the finality of the present Office Action.

¹ The Bearer Independent Call Control (BICC) limitation added to claim 1 was included in original claim 6, which includes limitations analogous to those of claim 1; the Transport Independent Call Control (TICC) limitation is analogous to BICC and is expressly described in the specification; and the Network Service Access Point (NASP) addressing format limitation, included in original claim 1, has been amended to expressly state that it is the format defined in ITU-T recommendation X.213, as expressly stated in the specification.

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b.) Examiner's Finding of Obviousness is Conclusory

The Examiner asserts that Denman discloses "conveying . . . addresses between peer media gateway controllers using bearer independent call control (BICC) or transport independent call control (TICC) by encapsulating [the] address using the network service point (NSAP) addressing format." A search of Denman, however, fails to disclose any discussion of the use of BICC, TICC or NSAP, in any form, much less the manner as recited in claim 1. Therefore, the Examiner's reliance on Denman as a primary reference in the rejection of claim 1 is unsupportable.

The Examiner does recognize, however, that Denman fails to disclose the use of the addressing format as defined in ITU-T recommendation X.213. To overcome the deficiencies of Denman, the Examiner has looked to the teachings of Reed, which the Examiner states "shows the addressing format as defined in ITU-T recommendation X.213." The Examiner then concludes that it would have been obvious to combine Denman with Reed, stating that "[t]he motivation would have been to have an open SS7 addressing scheme." The Examiner, however, does not point to any teaching or suggestion in Denman or Reed of such a motivation. Even if there were such a motivation in the prior art, it is conceivable there could be many solutions that would provide an "open SS7 addressing scheme." It is only the Applicants' claimed solution that is relevant to the obviousness inquiry, and the Examiner has pointed to no teachings in the prior art that would motivate one to arrive at the invention of claim 1. As stated in MPEP §706.02(j):

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter,

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either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

* * *

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. (emphasis added)

Whereas the Examiner has not provided any reasoning as to why one of ordinary skill in the art would have found the claimed invention obvious, the Examiner has failed to establish a *prima facie* case of obviousness. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claim 1 as being obvious over Denman in view of Reed.

Whereas independent claims 5 and 6 recite limitations analogous to those of claim 1, those claims are also not obvious over Denman in view of Reed. Furthermore, whereas claims 2-4 are dependent from claim 1, and include the limitations thereof, those claims are also not obvious. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-6.


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CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and Issue a Notice of Allowance for claims 1-6.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,


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